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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,252	03/21/2001	Nancy D. Hanson	180.0003 0103	6198
26813	7590	02/27/2004	EXAMINER	
MUETING, RAASCH & GEBHARDT, P.A. P.O. BOX 581415 MINNEAPOLIS, MN 55458			LU, FRANK WEI MIN	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/814,252

Applicant(s)

HANSON ET AL.

Examiner

Frank W Lu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached office action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 11.

Claim(s) objected to: 57.

Claim(s) rejected: 56.

Claim(s) withdrawn from consideration: 1,2,4,5,7-10,17-21,24-27,30-38 and 49-55.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

1. The proposed amendments filed on January 27, 2004 have been fully considered but will not be entered because: (1) they raise new issues that would require further consideration and/or search; and (2) they are not deemed to place the application in better form for appeal by material reducing or simplifying the issues for appeal.

Response to Arguments

I. In page 5, third paragraph of applicant's remarks, applicant argues that "[A]lthough Applicants do not agree with the Restriction Requirement, all claims to primers, methods or kits that do not include reference to the PSE1, PSE4, CARB3 beta-lactamase enzymes have been canceled. Applicants have also amended method claims 17 and 38 to be specific to such enzymes. Thus, reconsideration and withdrawal of the restriction with respect to these two method claims is respectfully requested. Because the kit claims with analogous language have been examined, it is respectfully submitted that this should not involve an undue burden."

These arguments have been fully considered but they are not persuasive toward the withdrawal of the restriction requirement because applicant's arguments with respect to the restriction requirement are moot since applicant has amended claim 17. Since the amended claim 17 is different from original filed claim 17, proposed amendments in claim 17 raise new issues that would require further consideration. Since applicant does not cancel nonelected claims 17 and 38 in the proposed amendment, the proposed amendment are not deemed to place the application in better form for appeal by material reducing or simplifying the issues for appeal.

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II. In page 5, last paragraph bridging to page 6, first paragraph of applicant's remarks, applicant argues that "[C]laim 56 has been amended to clarify that the kit is for detecting a PSE1, PSE4, or CARB3 family beta-lactamase within Gram Negative organisms using a primer pair characteristic of the PSE1, PSE4, and CARB3 families of beta-lactamase enzymes, wherein each primer includes 15-35 nucleotides." since "[N]one of the cited art teaches or suggests the use of primers of 15-35 nucleotides pairs (as opposed to probes of much larger size as disclosed by Arlet) that are characteristic of the PSE1, PSE4, and (CARB3 families of beta-lactamase enzymes.".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection because applicant's arguments with respect to claim 56 are moot since applicant has amended claim 56. The proposed amendments in claim 56 raise new issues that would require further consideration and/or search. For example, the phrase "wherein each primer of the pair includes 15-35 nucleotides" in claim 56 is a new limitation and is not found in claim 56 amended on July 8, 2003.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571)272-0782.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
PSA
February 24, 2004


BJ FORMAN, PH.D.
PRIMARY EXAMINER